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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91201703
Party	Plaintiff Michael Brandt Family Trust d/b/a Eco-Safe Industries, Inc.
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Date	01/11/2012
Attachments	229-182 Memorandum in Opposition.PDF ( 19 pages )(697157 bytes )

Application Ser. No. 77/960,950

In its Motion, Applicant alleges that Opposer's claim for fraud does not allege with sufficient particularity that Applicant acted with knowledge and with an intent to actually deceive the U. S Patent and Trademark Office. Applicant also alleges that Opposer has failed to state a claim upon which relief can be granted regarding Applicant's lack of *bona fide* intent since Opposer alleged only an "either/or " proposition (i.e., either Applicant has a *bona fide*

intent to use as a trademark or as a certification mark, but not both) rather than the fact Applicant lacks a *bona fide* intent for “all” listed products and certification services.

Suffice it to say, Applicant exalts form over substance, and can’t do indirectly what it cannot do directly. The simple matter is this: Applicant in its application has declared a *bona fide* intent to use and register the mark both as a trademark for a variety of products and also as a certification mark, for certifying the very same products upon which Applicant seeks registration. Such an intent and the fact Applicant is a certifying entity was re-affirmed by Applicant’s Answer to the Notice of Opposition. Applicant cannot have it both ways. By declaring under oath its intent to use the mark both as a trademark and as a certification mark, Applicant has committed an outright fraud on the U.S. Patent and Trademark Office. Nor can Applicant indirectly bypass the anti-use by owner rule of 15 U.S.C. §1054 by finding refuge in *Wet Seal, Inc. v. F.D. Management, Inc.*, 820 USPQ 2d 1829 (TTAB 2007). That decision is distinguishable because it did not involve an application that sought registration of the same mark for use both as a trademark and also as a certification mark.

For the foregoing reasons, Applicant’s Motion should be denied. In the event Opposer’s pleading is found technically deficient in any manner, an Amended Notice of Opposition is attached herewith as Exhibit A. And if found deficient, Opposer, in the alternative, moves for leave to substitute its Notice of Opposition with the Amended Notice of Opposition. Opposer sought Applicant’s consent to file an Amended Notice of Opposition, but did not receive Applicant’s response to its request.

### ARGUMENT

A motion to dismiss for failure to state a claim upon which relief can be granted is a test solely of the legal sufficiency of a complaint. As recognized in TMBP §503.02, “In order to

withstand such a motion, a complaint need only allege such facts that would, if proved, establish that the plaintiff is entitled to the relief sought.... To survive a motion to dismiss, a complaint must 'state a claim to relief that is plausible on its face.' " *Id. citing Bell Atlantic Corp v. Twombly*, 550 U.S. 554, 570 (2007). When reviewing such a motion, the allegations must be construed as to do justice and to determine whether the complaint contains any allegations, which if proved, would entitle the plaintiff to the relief sought. *See e.g., IdeasOne Inc. v. Nationwide Better Health*, 89 USPQ 2d 1952, 1953 (TTAB 2009).

A complaint or notice of opposition may be amended within 21 days after service of a motion to dismiss or with the written consent of the adverse party or by leave of the Board, which is freely given when justice so requires. TMBP §503.03 *citing* Fed. R. Civ. P. 15(a)(1)(B). Thus, often times, in response to a motion to dismiss, the plaintiff or opposer respond to a motion to dismiss by filing an amended complaint. If the amended complaint corrects the defects noted in the motion to dismiss and states a claim upon which relief can be granted, then the motion to dismiss normally will be declared moot. *Id. citing Fair Indigo LLC v. Style Conscience*, 85 USPQ 2d 1536, 1537 (TTAB 2007).

**I. The Notice of Opposition Properly States a Claim that Applicant is Violating the Anti-Use by Owner Rule of 15 U.S.C. § 1054**

15 U.S.C. § 1054 states as follows:

Subject to the provisions relating to the registration of trademarks, so far as they are applicable, collective and certification marks, including indications of regional origin, shall be registrable under this chapter, in the same manner and with the same effect as are trademarks, by persons, and nations, States and municipalities, and the like, exercising legitimate control over the use of the marks sought to be registered, even though not possessing an industrial or commercial establishment, and when registered they shall be entitled to the protection provided in this chapter in the case of trademarks, **except in the case of certification marks when used so as to represent falsely that the owner or a user thereof makes or sells the**

**goods or performs the services on or in connection with which such mark is used.** Applications and procedure under this section shall conform as nearly as practicable to those prescribed for the registration of trademarks.

Known as the anti-use by owner rule, the holder of a certification mark cannot also be engaged in the production or making of any goods or services to which the certification mark is to be applied. Nor can the holder of a certification mark permit use of the mark for purposes other than to certify products or services. It makes no difference whether the Applicant seeks registration within the parameters of International Class A or B, or as a service mark in International Class 42. The Board may and has in fact moved beyond the actual description in an application to determine how the mark is actually being used, or in the case of an intent to use application, how the applicant intends to use the mark. For example, *In re Allied Stores Corp*, 153 USPQ 84 (TTAB 1967), the Board looked beyond the stated description and reviewed the specimens to determine actual use of the mark. The Board held that the mark was being used in a manner of a certification mark, not as a trademark or service mark.

In the event an applicant seeks registration of a mark for use as both a trademark and a certification mark, the application is *void ab initio* as a matter of law -- there is simply no way around this fact. Indeed, applications solely for certification marks have been found *void ab initio* when the applicant already had a registration for the same mark for use as a trade or service mark, and the products and services were the very items certified by the applicant. *In re Celanese Corp. of America*, 136 USPQ 86 (TTAB 1962). "The primary reason for this rule is that dual usage of the mark would improperly compromise the objectivity of the certifier if it were competing in the market that it certified." J. Thomas McCarthy, McCarthy on Trademarks, Section 19:94 p. 19-302 (2010).

As applied to the case at hand, Opposer has plead sufficient facts in its notice of opposition, that if true, states a claim upon which relief can be granted. See Notice of Opposition, paragraphs 9-13.

If Applicant has a *bona fide* intention to use the mark as both a trademark for classes 22, 23, 24, 25 and 27 and also for certification services in class 42, then Applicant has violated the anti-use by owner rule, and the application is *void ab initio*.

If Applicant has a *bona fide* intention to use the mark only for certification services, namely in certifying the products in classes 22, 23, 24, 25 and 27, then as a matter of law it cannot also have a *bona fide* intent to use the mark as a trademark for products it lists in classes 22, 23, 24, 25 and 27. Again, such a *bona fide* intent would be in violation of 15 U.S.C. §1054.

If Applicant only has a *bona fide* intent to use the mark for the products in classes 22, 23, 24, 25 and 27, and after further reflection, no longer has a *bona fide* intent to use the mark for the certification services in class 42, and proceeds to abandon that class, then Opposer challenges that alleged *bona fide* intent because, as admitted by Applicant in Paragraph 9 of its Answer, Applicant is in fact an entity that is engaged in certification, not in the manufacture or productions of products. As a consequence, Applicant cannot have a *bona fide* intent to use the mark as a trademark in commerce with the United States. If such allegations are true, then registration should be refused for lack of a *bona fide* intent to use as a trademark for the products in classes 22, 23, 24, 25 and 27.

To assert as does Applicant on pages 2-3 of its Motion, that Opposer needs to claim that applicant lacks a *bona fide* intent to use the mark for all goods and services, exalts technical form over the substance of the anti-use by owner rule. While that burden might be necessary when the application involves both products and non-certification services, it cannot and arguably should

not apply when as here, the application covers **both** products and certification services. Otherwise, such a holding would render §1054 of the Act meaningless. Applicant's attempt to construct a bypass around the statutory language is in contravention of the clear will of Congress. While imaginative and perhaps bodacious, Applicant's argument fails by weight of sheer statutory construction and long standing application. Applicant stated its clear intent under oath to use the mark both as a trademark and as a certification mark -- a clear intent to violate the law and should not be permitted to find sheltered refuge in *Wet Seal, supra*, a decision that is distinguishable from the facts at hand.

## **II. Opposer's Notice of Opposition States a Claim for Fraud upon Which Relief can be Granted**

Opposer does not dispute that by reason of the Federal Circuit's relatively recent decision in *In Re Bose Corporation*, 580 F.3d 1240 (Fed. Cir. 2009), that the standard for fraud has been clarified. Indeed, Opposer does not dispute that to state a claim for fraud, three key elements are necessary:

1. the applicant or registrant must knowingly make a false material representation.
2. that the false material representation was made with the intent to deceive the PTO, and finally,
3. that the PTO relied upon the material false representation.

Where Opposer and Applicant disagree, is whether these three elements must be premised on language that is commonly used as implicitly asserted by Applicant, or whether such elements may be stated in other ways, albeit uncommon, as asserted by Opposer herein.

In this connection, Applicant's false statements are found in paragraphs 10 and 11 of the Notice of Opposition where Applicant stated its *bona fide* intention to use the mark as a

trademark on the one hand, and as a certification mark on the other. Applicant's *bona fide* intention is false because it is contrary to law. Applicant and its attorney are inherently charged with knowledge of the law. It is no defense to claim that one is unaware of the law, or that its actions to claim both use as a trademark and as a certification mark was inadvertent. As noted in paragraph 10 of the Notice of Opposition, during prosecution, Applicant sought an amendment to the description of goods and services that clearly set forth its intent to certify the various products in classes 22, 23, 24, 25, and 27. This was not by happenstance, but by clear deliberate design.

The allegations that the false representations were made with an intent to deceive the U.S. Patent and Trademark Office are found in paragraph 12: "Applicant has fraudulently misrepresented and falsely represented to the United States Patent and Trademark Office its true *bona fide* intentions..."

Finally, the allegation about the Examining Attorney's reliance is found at the conclusion of paragraph 12.

While one may take issue with semantics and parse each and every word, the Notice of Opposition clearly states a claim of fraud upon which relief may be granted. Applicant is charged with notice of the claim and has already responded to the allegations. Nevertheless, to avoid any further debate and delay, Opposer attaches herewith an Amended Notice of Opposition and respectfully moves for leave to substitute the Amended Notice of Opposition in the event the Board should find the initial pleading deficient in any manner.

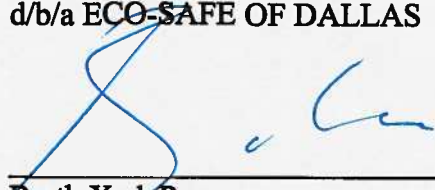
In view thereof, Applicant's Motion to dismiss should be denied. Further action is respectfully solicited.



Respectfully submitted,

MICHAEL BRANDT FAMILY TRUST  
d/b/a ECO-SAFE OF DALLAS

Dated: January 11, 2012



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*Counsel for Opposer*

## **CERTIFICATE OF SERVICE**

The undersigned hereby certifies that a true and correct copy of the Memorandum in Opposition to Applicant's Motion to Dismiss and/or Leave to File Amended Notice of Opposition has been served upon Applicant this 11th day of January, 2012, via first class mail, postage prepaid, as identified below:

Mark Lebow  
Young & Thompson  
209 Madison Street  
Suite 500  
Alexandria, VA 22314-1764



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Barth X. DeRosa

# **EXHIBIT A**

## **AMENDED NOTICE OF OPPOSITION**

In the matter of U.S. Trademark Application Serial No. 77/960,950 covering the mark “ECO-SAFE & Leaf Design” filed March 17, 2010 under Section 44(e) by Istituto Italiano Sicurezza dei Giocattoli S.r.L., a limited liability company doing business under the laws of Italy (hereinafter called “Applicant”), having a principal place of business at Via Europa, 28 Cabiato (COMO) 22060, Italy, published May 24, 2011, time being extended, Opposer, Michael Brandt Family Trust d/b/a Eco-Safe of Dallas (hereinafter called “Opposer”), a Trust organized under the laws of Texas, located and doing business at 3001 Wheelock Street, Dallas, Texas 75220-2944, believes that it will be damaged by registration of Application Serial No. 77/960,950 and hereby opposes the registration of the mark “ECO-SAFE & Leaf Design.” The grounds for opposition under Section 2(d) of the Lanham Act, as amended, and for fraud, on information and belief, are as follows:

**Likelihood of Confusion Under Section 2(d)**

1. Since long prior to March 17, 2010, Applicant's alleged constructive use date, Opposer has, through its predecessor, been and is now engaged in the offering and selling of pest control and janitorial related services and also in the manufacture, distribution and sale of pet related products, pest control and sanitary related products, including, but not limited to, carpet freshening preparations, flea control agents, liquid hand soaps, insecticides in spray, powder or liquid forms for domestic, commercial and industrial use, and pest control traps for rats, roaches and other pests, and has continuously used in interstate commerce in connection with such products and services the "ECO-SAFE" mark and name.

2. Since long prior to March 17, 2010, Applicant's alleged constructive use date, Opposer did, through its various licensees, trade as Eco-Safe and presently trades under said name.

3. Since long prior to March 17, 2010, Applicant's alleged constructive use date, Opposer did sell the products and services identified in paragraph 1 herein to customers in the United States in connection with the "ECO-SAFE" mark and name, and is presently using said mark and name in commerce.

4. Opposer relies upon and is the owner of the following registrations, all of which are valid, subsisting, unrevoked and, where applicable, incontestable.

Registration No. 1,749,733  
"ECO-SAFE" in International Classes 3, 5, 21, 25, 26, and 37  
Dated: February 2, 1993  
Renewed: March 26, 2003

Registration No. 1,631,876  
"ECO-SAFE and Design" in International Class 37  
Dated: January 15, 1991  
Renewed: March 21, 2001

Registration No. 1,303,116  
"ECO-SAFE" in International Class 37  
Dated: October 20, 1984  
Renewed: August 7, 2004

Certified status and title copies of the above registrations will be provided at a later date.

5. The products of Applicant, namely, Ropes, string, fishing nets, tents, awnings, tarpaulins, sails, sacks and bags for the transportation or storage of materials in bulk; padding and stuffing materials not of rubber, paper or plastic; raw fibrous textile materials; Yarns and threads, for textile use; Textile fabrics for use in making clothing and household furnishings; knitted fabrics, curtains, pillow cases, bed quilts, quilt covers, duvets, duvet covers, bed sheets, bed spreads, bed blankets, comforters for bed, table cloths not of paper, textile napkins, towels, textile place mats; Clothing, namely, coats, mantles, raincoats, dusters, fur coats, dresses, suits, skirts, jackets, knitwear shirts, trousers, shorts sets, Bermuda shorts, jeans, waistcoats, shirts, t-shirts, tops, blouses, sweaters, blazers, cardigans, stockings, socks, underwear, corsets, brassiere, underpants, night-gowns, shifts, pajamas, nightwear, outerwear coats, hosiery, overalls, salopettes, dungarees, bonnet, clogs, bathrobes, bathing suits, beach-wraps, sun suits, sport jackets, waterproof jackets, wind-resistant jackets, anoraks, sweatsuits, ties, neckties, scarves, shawls, mufflers, foulards, caps, hats, hoods, gloves, sashes, belts; footwear, beach footwear, athletic footwear, boots, shoes and slippers; Carpets, rugs, mats and matting, linoleum for covering existing floors, Floor coverings of rubber and synthetic rubber, Hard surface coverings for floors, Non-textile wall hangings; and Testing, analysis and evaluation of the textile products of others and toys of others for the purpose of certification, are apt to move within similar channels of trade as the goods and services offered by Opposer and as described in paragraphs 1-4 herein. Many of the products and services distributed and sold by Opposer under the ECO-

SAFE mark and name are likely to be purchased and used by the same class of persons who are likely to purchase Applicant's various products and services set forth in paragraph 5 herein.

6. Applicant's mark "ECO-SAFE & Leaf Design" is so confusingly similar in all respects to Opposer's "ECO-SAFE" mark and name, which the public and the trade have long associated and recognized with Opposer, as to be likely, when applied to the goods of the Applicant, to cause confusion or to deceive purchasers in the mistaken belief that the products of the Applicant emanate from, are offered for sale, or are sold under Opposer's approval, sponsorship, or control all to the great damage of Opposer. Said use by Applicant is also apt to create reverse confusion or confusion as to sponsorship and certification by leading purchasers to believe that Opposer's products are sponsored or certified by Applicant or vice versa when they are in fact not so sponsored or certified, leading such potential purchasers to believe that Opposer is in fact an unauthorized user of the ECO-SAFE mark for its products and services, when in fact it is the lawful owner.

7. On information and belief, Applicant has made no use of the mark "ECO-SAFE & Leaf Design" in the United States for any product or service prior to March 17, 2010, which is Applicant's alleged constructive use date for the mark listed in International Classes 22, 23, 24, 25, 27 and 42.

8. Opposer has expended considerable time, effort and money in advertising and otherwise promoting the sale of its goods and services and encouraging the public and trade to recognize its "ECO-SAFE" mark and name, that unless refused, the registration obtained by Applicant will enable the Applicant to reap the benefits of such good will attached to Opposer's mark and name, and Opposer will suffer irreparable damage and injury as a result of the confusion that is likely to arise from its inability to control its reputation, as well as its inability

to control the ill effects associated with the likelihood of reverse confusion and confusion as to sponsorship and improper certification.

**Fraud and/or Violation of the Anti-Use by Owner Rule for Certification Marks**

9. On information and belief, Applicant is an institution based in Italy that certifies various products manufactured by others as to whether such product meets unspecified standards of quality for “environmentally friendly” products.

10. Applicant, in fact, proposed during prosecution of its application that it be permitted to amend its description of services in class 42 to read “testing, analysis and evaluation of the goods and services of others for the purpose of certification, all the aforesaid services related to above mentioned lists of products belonging to classes 22, 23, 24, 25 and 27.”

11. Insofar as Applicant has declared a *bona fide* intention to use the “ECO-SAFE & Leaf Design” mark with the products belonging to classes 22, 23, 24, 25 and 27 in commerce in connection with the sale or offering of such products, said *bona fide* intention is, as a matter of law, inconsistent with the anti-use by owner rule for certification marks under 15 U.S.C. §1054, and Applicant’s Serial No. 77/960,950 is therefore *void ab initio*.

12. Insofar as Applicant cannot as a matter of law have, on the one hand, a *bona fide* intent to provide testing, analysis and evaluation of the goods and services of others for the purposes of certification, and on the other hand, the *bona fide* intent to affix its certification mark to goods it actually intends to offer or sell in commerce as defined in 15 U.S.C. §1127, Applicant has fraudulently misrepresented and falsely represented to the United States Patent and Trademark Office its true *bona fide* intention with regard to the use of said mark in commerce with the United States, and the application should be refused by reason of Applicant’s fraud,



misrepresentation, and false representation before the U.S.P.T.O., upon which the Examining Attorney relied.

13. On information and belief, Applicant had knowledge of its fraudulent misrepresentation set forth in Paragraph 12 herein, and had an affirmative intent to deceive the U.S. Patent and Trademark Office by seeking on the one hand a trademark for the goods specified in Classes 22, 23, 24, 25 and 27 and, on the other hand, a certified mark for the "testing, analysis and evaluation of the goods and services of others for the purpose of certification" all under the deceitful guise of a service mark in Class 42.

14. In the alternative, in the event Applicant has committed a mistake and does not have a *bona fide* intent to use the marks for the class 42 services, then, based on information and belief, Applicant lacks a *bona fide* intent to use the mark for all the goods and services listed in classes 22, 23, 24, 25 and 27, and the application should be again declared *void ab initio*.

15. On information and belief, Applicant's declared *bona fide* intent to use the mark for all the goods in Class 22, 23, 24, 25 and 27 is a fraudulent and false representation made to the U.S. Patent and Trademark Office, since Applicant, on information and belief, is not in the position of manufacturing the various products listed in Classes 22, 23, 24, 25, and 27. Nor is it in the position to grant licenses under the mark to third parties for the use of the mark in connection with the manufacturing of the products listed in Classes 22, 23, 24, 25 and 27. Under the circumstances, Applicant lacks the necessary *bona fide* intent to use the mark as a trademark in connection with the listed products in Classes 22, 23, 24, 25 and 27.

16. On information and belief, Applicant made its declaration of a *bona fide* intent to use the mark with full knowledge that it had no such intent, and said false declaration of *bona fide* was made with the intent to deceive the U.S. Patent and Trademark Office in an effort to

fraudulently obtain a trademark together with a certification mark to which it is not entitled. The U.S. Patent and Trademark Office relied upon such a fraudulent representation when it cleared and passed the mark on to publication.

17. By reason of Applicant's fraud, the application should be refused, and by reason of Applicant's *bona fide* intent to use as a certification mark as well as a trademark, all in violation of the anti-use of owner rule under 15 U.S.C. §1054, said application should be declared *void ab initio*.

18. In the alternative or in tandem with the foregoing, by reason of the likelihood of confusion and potential for reverse confusion with Opposer's previously used marks, Opposer's Notice of Opposition should be sustained under Section 2(d) as well.

WHEREFORE, Opposer, by and through its counsel, respectfully prays that the mark sought to be registered by Applicant be refused and the Notice of Opposition be sustained.


The \$1,800.00 government fee (International Classes 22, 23, 24, 25, 27 and 42) is submitted herewith. Please charge any deficiency or credit any overpayment to Deposit Account No. 04-1061.

Please recognize Barth X. deRosa, Samuel D. Littlepage, Nicole M. Meyer, Jonathan Redway, Steven D. Lustig and Melissa Alcantara, all members of a Bar, and the firm of Dickinson Wright PLLC, 1875 Eye Street, N.W., Suite 1200, Washington, D.C. 20006, as attorneys for Opposer.

Respectfully submitted,

MICHAEL BRANDT FAMILY TRUST  
d/b/a ECO-SAFE OF DALLAS

Dated: January 11, 2012



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*Counsel for Opposer*

DC 229-182 182574v1

**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that a true and correct copy of the Amended Notice of Opposition has been served upon Applicant this 11th day of January, 2012, via first class mail, postage prepaid, as identified below:

Mark Lebow  
Young & Thompson  
209 Madison Street  
Suite 500  
Alexandria, VA 22314-1764



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Barth X. DeRosa